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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Burgess et al.
Serial No. 09/880,652
Filed: August 14, 2001
Examiner: Arthur, Lisa B.
Group Art Unit: 1600
Title: Methods of Labeling Biomolecules
with Fluorescent Dyes

HONORABLE ASSISTANT COMMISSIONER
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WASHINGTON, D.C. 20231

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Shannon Judice
Shannon Judice

7/18/02
Date

Dear Sir:

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

This paper is filed in response to the Office Action dated June 18, 2002 (Paper No. 6). The Examiner required an election of the claimed invention among Group I (Claims 13-19), Group II (Claims 20-32), Group II (Claims 33-43) and Group IV (Claims 44-58).

Applicants respectfully traverse the restriction requirement for several reasons. However, to reduce time and cost required to obtain patent protection, Applicants present only one argument regarding the restriction between Groups II

and III in the present response. Pursuant to the requirement imposed by 37 C.F.R. §1.143, Applicants provisionally elect Group II.

The Examiner indicates that Group II claims "are drawn to a method of labeling a biomolecule with a fluorescent dye that comprises a UV chromophore and a fluorescent emitter as classified in, for example, Class 536, subclass 26.6". The Examiner also indicated that Group III claims "are drawn to a method of labeling a biomolecule with a fluorescent dye comprising an anthracene derivative and BODIPY fragment as classified in, for example, Class 536, subclass 25.32".

Applicants assert that Claim 20 may include a BODIPY fragment conjugated to an anthracene derivative such as claimed in Claim 33. This is evidenced, *inter alia*, by dependent Claims 21 and 23. If Claim 30 were presented separately from Claim 20, absent a restriction requirement, a double patenting rejection might be proper. Therefore, under MPEP 806, Applicants assert that a restriction requirement is not proper. This does not however, in any way indicate that Claims 20 and 33 have identical scope or otherwise correlate with one another. While the claims are not patentably distinct, they do emphasize different aspects of the invention. Applicants also in no way intend to limit their right to pursue Claims 20-32 and Claims 33-43 in separate applications free of any double patenting rejections should the Examiner persist the in the restriction requirement.

Under MPEP 808.02, when two inventions are related, but not patentably distinct, the Examiner must show one of three things: (A) The inventions are separately classified, (B) the inventions have a separate status in the art even if classified together, and (C) a different field of search is required.

The Examiner has indicated that Group II should be classified in Class 536, subclass 26.6, while Group III should be classified in Class 536, subclass 25.32.

According to the Manual of U.S. Patent Classification, Class 536, Subclass 26.6 includes: "Compounds to which a marker (chemical, radioactive, fluorescent, etc.) has been added to indicate its presence. "Labelled (e.g., tagged with radioactive tracer, fluorescent marker, intercalator, etc.)." This subclass is indented under subclass 26.1 which includes: "Phosphorus containing N-glycoside wherein the N is part of an N-hetero ring: This subclass is indented under subclass 22.1. Compounds which are N-glycosides which contain phosphorus and wherein the N of the N-glycoside moiety is part of a nitrogen containing hetero ring. (1) Note. Nucleotides are provided for in this and indented subclasses."

Class 536, Subclass 25.32 includes: "Labels or markers utilized (e.g., radiotracer, affinity, fluorescent, phosphorescent markers, etc.) Processes for the synthesis of polynucleotides or oligonucleotides in which a label or marker is used to indicate the presence of a particular product". Indented under subclass 25.3 which includes: Synthesis of

polynucleotides or oligonucleotides: This subclass is indented under subclass 22.1. Process for the synthesis of polynucleotides or oligonucleotides, which process may be, or include, a crosslinking step.

As the above quotations make clear, subclass 26.6 is directed to labeling a N and P-containing molecule, such as a nucleic acid. Subclass 25.32 is directed to labeling a nucleic acid during synthesis. Given that Applicants' invention as embodied in both Claims 20 and 33 is applicable to both pre-formed nucleic acids as well as nucleotides used later in synthesis, the classification of the Groups into these two separate subclasses appears arbitrary. In Applicants' opinion, both subclasses may equally apply to both the claims of Group II and Group III. Furthermore, additional subclasses addressing protein or peptide labeling also apply.

Applicants respectfully request some additional explanation as to why the claims of Groups II and III, should be grouped in separate subclasses should the Examiner persist with this restriction.

Applicants assert that not only is separate classification of the inventions of Groups II and III inappropriate, they also do not occupy separate status in the art. The groups of claims do not represent "separate subjects for inventive effort" because both are related to labeling with a chromophore/fluorescent emitter conjugate. Should the Examiner assert otherwise, an explanation of the basis for such an assertion is respectfully requested.

Finally, the claims of Groups II and III do not require a different field of search. The overlapping nature of the claims as described in relation to field of classification is applicable to field of search as well. Applicants believe that any search conducted for Group III may be applicable to Group II as well. Therefore the field of search for Group II includes and subsumes the field of search for Group III.

As a result, Applicants assert that a restriction between Groups II and III is inappropriate under MPEP 808.02 and request that the restriction requirement between these two groups be withdrawn.

Should the Examiner find the above arguments persuasive, Applicants elect the new Group including Groups II and III for prosecution in the present application and withdraw Claim 13-19 and 44-58 from consideration and cancel such claims without prejudice or disclaimer. Such claims are subject to the filing of a divisional application thereon.

Otherwise, Applicants provisionally elect Group II for prosecution in the present application and withdraw Claim 13-19 and 33-58 from consideration and cancel such claims without prejudice or disclaimer. Such claims are subject to the filing of a divisional application thereon.

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CONCLUSION

Applicants have now made an earnest effort to place this case in condition for examination and allowance. Applicants respectfully request reconsideration of the application and combination of Groups II and III as well as allowance of the pending claims.

No fee appears to be due for this election, however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2580.

Respectfully submitted,



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